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Paper No. 28

Ex parte Jean-Yves Chenard, et al : Decision on Petition
Serial No. 254,313 : filed
Filed: 4/15/81 : July 6, 1984
For: Stabilization Of Vinyl Halide :
Polymers :

This is a decision on the petition, filed July 6, 1984, requesting withdrawal of the requirement to copy claims for purpose of instituting an interference. The petition will be considered under the provisions of 37 CFR 1.181.

The facts in the examining sequence appears substantially outlined on pages 2 and 3 on petition and will not be repeated here. It is the requirement of the Examiner to copy suggested claims 1 through 21 in the Office letter of June 14, 1984 that applicants now seek relief.

This is the second such requirement of the Examiner and in each instance it was made unmistakably clear that the failure to copy the subject matter involved within the required time would be considered a disclaimer of the subject matter.

In each requirement in this record, the attorney for applicants make the allegation that the application does not have support in this application for the limitations and definitions in the patented claims or those suggested and there is no overlap. It is his opinion then that there should not be an interference here.

The action of the Examiner has been reviewed as is proper. It is believed that the decision in Squires v. Corbett, 194 USPQ 518 is completely apposite here and would be dispositive of the question of support and overlap for interference purposes and reads in pertinent part as follows:

"As a prerequisite of the declaration of an interference under 35 USC 135(a) and 37 CFR 1.201(a), the Commissioner must decide that the "application claim," whether or not

identical to the "patent claim," is both patentable and drawn to substantially the same invention as the "patent claim". Failure of either condition precludes the possibility of interference contemplated by the statute. The "count," on the other hand, is merely the vehicle for contesting priority which, in the opinion of the Commissioner, effectively circumscribes the interfering subject matter, thereby determining what evidence will be regarded as relevant on the issue of priority. The "count," as distinguished from a party's "claim," need not be patentable to either party in the sense of being fully supported by either party's disclosure. In fact, where the interference is conducted on a "phantom" count, as described in §1101.02 of the Manual of Patent Examining Procedure (Third Ed.), or on the basis of a modified patent claim in accordance with 37 CFR 1.205(a), at least one party, by definition, will not have full support for all of the limitations of the count."

Accordingly, the argument on petition with regard to support and breadth of the count is not found to be reason to not comply with the requirement of the Examiner and requires no supervisory intervention.

Similarly, the allegation that copying the suggested claims are barred under Section 135(b), Title 35 is without merit since the Examiner considers the application claims to be drawn to substantially the same invention as the patented claims. It must be remembered that the Primary Examiner makes this determination.

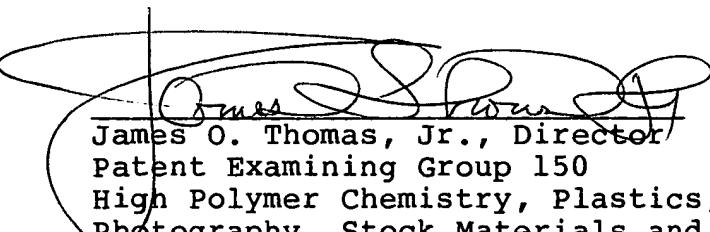
Insofar as the Examiner withdrawing the earlier requirement to copy claims on the basis of no overlap and agreeing with applicants as urged on petition, it is interesting that the attorney for applicants failed to mention that in this same Office letter the claims in this application were rejected on the patented claims he refused to copy under the provisions of Section 102(b), Title 35. Clearly, this indicates overlap. The comments by the Examiner in this regard appears misplaced. At the very least it is not an indication that the Primary Examiner considered the inventions patentably distinct.

The urging on petition that this application was pending with the application that matured into U.S. Patent 4,360,619 and should have been placed in interference then rather than now has been noted. The Examiner advised the attorney for applicants that this case was being considered for possible interference in view of 37 CFR 1.202 in an Office letter dated September 29, 1982. The outcome of that procedure would determine whether the application should have been placed in interference. Therefore, the charge of burdening and placing applicants at a disadvantage is unwarranted.

For all of the foregoing, no error is found on the part of the Primary Examiner requiring supervisory intervention here and it will not be done.

The application will be returned to her for action as appropriate if no timely response has been made pursuant to the provisions of Sections 714.03 and 706.03(u) of the Manual of Patent Examining Procedure since the filing of a petition will not stay the period for reply, 37 CFR 1.181(f).

The petition is DENIED.



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